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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,006	02/01/2001	Thomas Hottkowitz	2923-123	6539

6449 7590 02/28/2003

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WASHINGTON, DC 20005

EXAMINER

STOCKTON, LAURA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on January 10, 2003

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~which~~ whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-30, 32-35 and 43-45 are pending in the application.  
Of the above, claim(s) 16-30, 32, 34 and 35 are withdrawn from consideration.  
☐ Claim(s) is/are allowed.  
☒ Claim(s) 1-15, 33 and 43-45 are rejected.  
☐ Claim(s) is/are objected to.  
☐ Claim(s) are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.  
☐ The specification is objected to by the Examiner.  
☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.  
☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892  
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_  
☐ Interview Summary, PTO-413  
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948  
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/762,006

## DETAILED ACTION

Claims 1-30, 32-35 and 43-45 are pending in the application.

### *Election/Restrictions*

Applicants' election with traverse of Group XI and the species of compound 372 in Paper No. 9 was acknowledged in the previous Office Action. The requirement was deemed proper and made FINAL in the previous Office Action.

Subject matter not embraced by elected Group XI and claims 16-30, 32, 34 and 35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

The rejection of the claims over AT 393505 under 35 U.S.C. 102(b) has been overcome by the amendment to the claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, 33 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over AT 393505 and Eibl et al. {EP 534,445}, each taken alone.

***Determination of the scope and content of the prior art (MPEP §2141.01)***

Applicants claim phosphates and phosphoamines. AT 393505 teaches phosphates and phosphoamines which are structurally similar to the instant claimed compounds (see page 9, lines 22-47 and especially Examples 13 and 14 on page 18). Eibl et al. also teach phosphate esters which are structurally similar to the instant claimed compounds (page 2, lines 25-42 and Example 5 on page 6).

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between some of the compounds of the prior art and the compounds instantly claimed is that of generic description.

*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*

The indiscriminate selection of "some" among "many" is *prima facie* obvious. The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g. cytotoxic activity). One skilled in the art would thus be motivated to prepare compounds embraced by the prior art to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would have cytotoxic activity and be used to treat tumors. Therefore, the instant claimed compounds would have been suggested to one skilled in the art.

*Response to Arguments*

Applicants' arguments filed January 10, 2003 have been fully considered. Applicants argue that it would not have been obvious to

select specific compounds among the numerous compounds taught by the prior art since the prior art does not provide any guidance or suggestion leading to the compounds of the present invention.

Applicants argue the breadth of the teachings in each of the prior art references.

All of Applicants' arguments have been considered but have not been found persuasive. Applicants claim phosphates and phosphoamines. AT 393505 teaches phosphates and phosphoamines which are structurally similar to the instant claimed compounds (see page 9, lines 22-47 and especially Examples 13 and 14 on page 18). Eibl et al. also teach phosphate esters which are structurally similar to the instant claimed compounds (page 2, lines 25-42 and Example 5 on page 6).

The compounds being claimed in the instant claimed invention are generically described in the prior art references. The specific examples prepared in the prior art references differ from Applicants' compounds by a methylene group {e.g.,  $-\text{CH}_2-$ }. For instance, in comparison of instant claim 1 and Example 14 on page 18 in AT 393505 {applied under 35

U.S.C. § 102(b) in the previous Office Action}, the difference is a methylene group. See in instant claim 1 wherein  $p+q$  is 13 ( $p$  is 8 and  $q$  is 5) and Example 14 in AT 393505 wherein  $p+q$  is 12 ( $p$  is 8 and  $q$  is 4). The difference being a pentyl group in the instant claimed invention versus a butyl group in the prior art. Therefore, the examples in the prior art would lead one skilled in the art to the instant claimed invention.

### *Conclusion*

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened

statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

This application contains subject matter drawn to inventions nonelected with traverse in Paper No. 9. A complete reply, if any, to the final rejection must include cancellation of nonelected subject matter (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

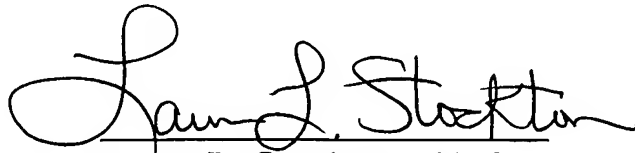


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The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

A handwritten signature in cursive script, reading "Laura L. Stockton". The signature is written in black ink and is positioned above the printed name.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

February 25, 2003